



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/882,435	06/25/97	HOXIE	J 9596-1101

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HM21/0323

EXAMINER

NELSON, B

ART UNIT	PAPER NUMBER
1648	

DATE MAILED: 03/23/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/882,435

Applicant(s)
James A. Hoxie

Examiner
Brett Nelson

Group Art Unit
1648



☒ Responsive to communication(s) filed on Feb 24, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 days month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-24 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-24 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, drawn to an anti-immunodeficiency antibody, classified in class 530, subclass 387.1, 388.1, 388.15, 388.21, 388.22, 388.3, or 388.35
 - II. Claims 11-18, drawn to an isolated DNA, classified in class 536, subclass 23.1 or 23.72.
 - III. Claim 19, drawn to a method of inhibiting infection of a cell by HIV, classified in class 424, subclass , 141.1, 143.1, or 148.1.
 - IV. Claim 20, drawn to a method of treating HIV in a human, classified in class 424, subclass 188.1.
 - V. Claim 21, drawn to a method of obtaining an anti-immunodeficiency virus antibody, classified in class 435, subclass 4.
 - VI. Claim 22, drawn to a method of identifying a target cell for immunodeficiency virus infection, classified in class 435, subclass 5, 7.1, or 7.2.
 - VII. Claim 23, drawn to a method of identifying a candidate anti-immunodeficiency virus compound, classified in class 435, subclass 6.
 - VIII. Claim 24, drawn to a method of measuring the level of expression of CXCR4 on a cell, classified in class 435, subclass 5, 7.1, 7.2, or 7.21.

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2. The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups I and II are unrelated products which have different structures and uses and are patentably distinct each over the other.

The inventions of Groups III-VIII are unrelated methods which have different steps and modes of operation, yield different results, and are patentably distinct each over the other.

Inventions I and III, IV, VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibodies can be used in many materially different process such as *in vivo* and *in vitro* methods.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the search required for one Group is not required for the other Groups, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

If Groups I or II are elected then applicant is required to elect one of the following species:

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- a) HIV-1 (claims 2 and 12), b) HIV-2 (claims 2 and 12), and
- c) SIV (claims 2 and 12).

If species a) HIV-1 or b) HIV-2 are elected then applicant is required to elect one of the following subspecies:

- aa) HIV receptor protein (claims 3, 4, 13, and 14), and
- bb) cellular co-factor for a cellular HIV receptor protein (claims 3, 5, 13, and 15).

If subspecies bb) cellular co-factor... is selected then applicant is required to elect one of the following subspecies:

- aaa) CXCR4 (claims 6-10 and 16-18), and
- bbb) CCR5 (claim 7-9 and 16).

The species and subspecies recite different antibodies or isolated DNA which have different structures, bind different moieties, and are patentably distinct each over the other.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Papers related to this application may be submitted to Group 1640 by facsimile transmission. Papers should be faxed to Examiner Brett Nelson, Art Unit 1648 and should be marked "OFFICIAL" for entry into prosecution history or "DRAFT" for consideration by the examiner without entry. The Art Unit 1648 FAX telephone number is (703)-305-7939. FAX machines will be available to receive transmissions 24 hours a day. In compliance with 1096 OG 30, the filing date accorded to each OFFICIAL fax transmission will be determined by the FAX machine's stamped date found on the last page of the transmission, unless that date is a Saturday, Sunday or Federal Holiday with the District of Columbia, in which case the OFFICIAL date of receipt will be the next business day.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Brett Nelson whose telephone number is (703) 306-3219.

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If the examiner can not be reached, inquiries can be directed to Primary Examiner Lynette F. Smith whose telephone number is (703) 308-3909 or Supervisory Patent Examiner Donald E. Adams whose telephone number is (703) 308-0570.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

NELSON/bn
March 19, 1998


PONNATHAPURA ACHUTAMURTHY
PRIMARY EXAMINER
GROUP 1800